REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicants have amended claim 1, and claim 2 has been canceled. Accordingly, claims 1 and 3-16 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102(e)

In paragraph 2 of the Office Action, the Examiner rejected claims 1, 5, 6, 7, 11 and 16 under 35 U.S.C. § 102(e) as being anticipated by Valentine, et al. (US 6,504,839). The Applicants have amended claim 1 to incorporate the limitations of dependent claim 2. In paragraph 3 of the Office Action, the Examiner stated that Valentine does not teach the limitations of claim 2. The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Valentine in view of Liu (US 6,130,879). As noted below, however, Valentine is disqualified as prior art under § 103(c) because Valentine and the instant application were commonly owned at the time the invention was made. This is further discussed in paragraph 3 below.

Liu, by itself, does not teach or suggest the claimed invention recited in amended claim 1. Therefore, the Applicants respectfully request the withdrawal of the rejection and the allowance of amended claim 1.

Claims 5, 6, 7, 11, and 16 depend from amended claim 1 and recite further limitations in combination with the novel elements of claim 1. Therefore, the allowance of claims 5, 6, 7, 11, and 16 is respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

In paragraph 3 of the Office Action, the Examiner rejected claims 2, 3, 4, 8, 12, 13 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Valentine in view of Liu (US 6,130,879). The Applicants contend, however, that under 35 U.S.C. § 103(c), Valentine does not qualify as prior art because Valentine and the instant application

were commonly owned at the time the invention was made (and still are). More specifically, MPEP 706.02(l)(1) states:

> Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design, and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues.

The instant application was filed on January 29, 2001. Applicant respectfully notes that the instant application as well as Valentine were, at the time the invention was made, all owned by the same entity – Telefonaktiebolaget LM Ericsson. Valentine indicates on its face that the Assignee is Ericsson Inc. This is a wholly owned subsidiary of Telefonaktiebolaget LM Ericsson. The ownership information for the instant application is shown in an assignment to Telefonaktiebolaget LM Ericsson, which was recorded with the U.S. Patent and Trademark Office on May 11, 2001 at reel/frame 011803/0201.

As a result, all of the requirements of 35 U.S.C. 103(c) have been met, and Valentine is disqualified as a prior art obviousness reference in the instant application. Liu, by itself, does not teach or suggest the claimed invention. Claim 2 has been canceled; therefore, the Applicants respectfully request the withdrawal of the rejection and the allowance of claims 3, 4, 8, 12, 13 and 15.

In paragraph 4 of the Office Action, the Examiner rejected claims 9, 10 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Valentine and further in view of Malmlof (US 6,594,241). As noted above, however, under 35 U.S.C. § 103(c), Valentine does not qualify as prior art because Valentine and the instant application were commonly owned at the time the invention was made. In addition, Malmlof does not qualify as prior art because Malmlof is also a 102(e)-type reference, and Malmlof and the instant application were commonly owned at the time the invention was made. Malmlof indicates on its face that the Assignee is Telefonaktiebolaget LM Ericsson, and

as noted above, the ownership information for the instant application is shown in an assignment to Telefonaktiebolaget LM Ericsson, which was recorded with the U.S. Patent and Trademark Office on May 11, 2001 at reel/frame 011803/0201.

As a result, all of the requirements of 35 U.S.C. 103(c) have been met, and both Valentine and Malmlof are disqualified as prior art obviousness references in the instant application. Therefore, the Applicants respectfully request the withdrawal of the rejection and the allowance of claims 9, 10, and 14.

CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1 and 3-16.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

Steven W. Smith

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Steven W. Smith
Registration No. 36,684

Ericsson Inc.
6300 Legacy Drive, M/S EVW 2-C-2
Plano, Texas 75024

(972) 583-1572
steve.xl.smith@ericsson.com